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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,157	03/17/2005	Michael Meged	MEGED1	6487
1444 7590 02/02/2009 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER				
OVEISSI, DAVID M				
ART UNIT		PAPER NUMBER		
2416				
MAIL DATE		DELIVERY MODE		
02/02/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/528,157

**Applicant(s)**

MEGED ET AL.

**Examiner**

DAVID OVEISSI

**Art Unit**

2416

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/10/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 11/10/2008 have been fully considered but they are not persuasive.

#### **Applicant's arguments:**

Applicant argued that the combined references Maggio et al. (EP 1339198 A1), Taniguchi (6,122,250), and Kimoto (US 6,920,603 B2) do not teach the recited claimed invention because each of these references are to solve different problems from the problem the applicant tries to solve.

Applicant argued that, the problem was recognized and formulated by the Inventors, namely: appearance of "isolated node" triggers a conventional squelching algorithm eliminating traffic which originates or terminates at the isolated node; the squelching causes loss of all Ethernet traffic enveloped by SDH/SONET containers, since the Ethernet traffic must perform termination/generation operations at every node of a ring network (see page 5, line 10 to page 6, line 10 of the original specification).

Applicant further argued that another "missing link" in the above-mentioned logical chain is set up of a task. The inventors have set up and have solved) the task to

overcome without utilizing additional, complex, heavy and expensive means on a higher level, such as STP protocol. Without recognizing the problem and setting up the task, a skilled person could not propose a) the very idea of protecting Ethernet traffic from elimination at the very SDH/SONET level in a ring network, and b) the solution to initiate suppression of the conventional squelching mechanism at least with respect to SDH/SONET containers carrying Ethernet traffic, and at least upon detecting appearance of the "isolated node" in the ring network.

These features of the invention are clearly defined in independent claims 1 and 8. Applicants would like to emphasize that they were the first to propose a solution to the newly recognized problem at the 1<sup>st</sup>, SDH/SONET, level (and not at a 2<sup>nd</sup> level Ethernet, requiring more complex and expensive tools).

It is therefore requested that, in view of the comments presented above, the Examiner reconsider his previous position and acknowledge that the invention claimed in Claims 1 and 8 satisfies the criteria of non-obviousness.

**Examiner Response:**

Examiner respectfully disagrees. Firstly, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Secondly, if the combined teachings of prior art is capable of performing the intended use, it meets the claim limitations. Thirdly, the recitation "the method is being performed at the SDH/SONET layer and includes utilizing MS\_SPRING/BLSR system for SDH/SONET

traffic protection and, in case of detecting at least one isolated node in the network" has not given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, and 6-10 are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Maggio et al. (EP 1339198 A1)** in view of **Taniguchi (6,122,250)** further in view of **Kimoto (US 6,920,603 B2)**.

For claims 1, 4 and 6-10 **Maggio** teaches a method/system/software for protecting Ethernet data packets transmitted over SDH/SONET traffic in a ring-like optical network formed by a number of nodes the method being performed at the SDH/SONET layer, (*see abstract "a method and device for handling "Ethernet frame signal in a SDH/SONET network, the SDH/SONET network comprising network elements or nodes... the new layer/network using the resources of SDH/SONET network in such a way as to optimize ...", paragraphs 1, 7, 9, 11, 15, 16, 20, 33, 36, 51"* In principle, SDH/SONET networks already provide different types of protection (for instance SNCP or MS\_SPRING) that can be applied to Ethernet frames as Ethernet frames are encapsulated into SDH/SONET Virtual Containers."), and includes utilizing MS-SPRING/BLSR system for SDH/SONET traffic protection and, in case of one or more network failures that result in at least one isolated node in the network (*see paragraph 82 In principle, SDH/SONET networks already provide different types of protection (for instance SNCP or MS\_SPRING) that can be applied to Ethernet frames as Ethernet frames are encapsulated into SDH/SONET Virtual Containers."*),

**Maggio** does not teach the method comprises preventing initiation of a squelching algorithm of the MS-SPRING/BLSR system with respect to the SDH/SONET virtual containers carrying the data Ethernet packets. Furthermore, **Taniguchi** from the same field of endeavor teaches this limitation (*see paragraph 150 "... a squelch operation is not executed... therefore no squelch operation is carried out between the two."*), Thus, it would have been obvious to the person of ordinary skill in the art at the time of invention to use the Miriello shared optical protection in the Maggio Ethernet over

SDH/SONET system. The motivation for this combination is to prevent squelching to use up the SDH/SONET resources.

Neither **Maggio** nor **Taniguchi** teach while ensuring that there is no standardized use of byte J1 (in the network, with respect to the SDH/SONET virtual containers carrying the Ethernet packets. However, **Kimoto** from the same field of endeavor teaches this limitation (see column 3 lines 53-57 "... unused byte such as the J1"). Thus, it would have been obvious to a person of ordinary skill to leave the J1 byte unused in the Miriello and Maggio system. The motivation for leaving J byte unused is not to waste the SDH/SONET resources. Provide more flexible system in terms of SDH/SONET traffic.

3. Claim 2 are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Maggio et al. (US 2003/0165153 A1)** in view of **Dupont (US 7,002,976 B2)**

For claim 2 **Maggio** does not teach explicitly a method, wherein the nodes of the network are ADM (Add Drop Multiplexer) nodes, although, it is well known in the art that SONET nodes consist of ADM. Furthermore, **Dupont** from the same field of endeavor teaches this limitation explicitly (see column 6 lines 9-25). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to use the ADM of **Dupont** in the SONET network of **Maggio**. The reason for this combination is to provide various incoming local area networks to be routed in the wide area network of

SONET.

4. Claim 3 is rejected under 35 U.S.C. 103 (a) as being unpatentable over **Maggio** in view of **Manganini et al. (US 2003/0026203 A1)**.

For claim 3 **Maggio** does not teach a method, wherein the virtual containers of the SDH/SONET traffic are AU-4/AU-3. However, **Manganini** from the same field of endeavor teaches this limitation (*see paragraphs 34 and 39*). Thus, it would have been obvious to the person of ordinary skill in the art at time of invention to use the AU of the **Manganini** in the SDH/SONET transport network of **Maggio**. The motivation for this combination is to distinguish between different traffic.

5. Claim 5 is rejected under 35 U.S.C. 103 (a) as being unpatentable over **Maggio** in view of **Miller (US 7,177,328 B2)**.



For claim 5 **Maggio** does not teach a method, comprising filling the J1 bytes of all the virtual containers carrying the Ethernet traffic by one and the same binary code word, thereby preventing the standardized use of the byte J1. Furthermore, Miller from the same field of endeavor teaches this limitation (*see column 10 lines 28-29*). Thus, it would have been obvious to a person of ordinary skill at the time of invention to disable using J1 by using **Miller** switch method in the **Maggio** MS-SPRING system. Furthermore applicant teaches this limitation (*see paragraph 37*). The motivation for this combination is to J1 byte can be used for any application.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: **Mesh et al. (US 2004/0109408 A1)**, **Kam et al. (US 2005/0041601 A1)**, and **Iga (5,570,371)**.
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571) 272-3139. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)? If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Ricky Ngo/  
Supervisory Patent Examiner, Art Unit 2416**